

Paper No. 4
COPY MAILED

JUL 03 2002

MCDONNELL BOEHNEN HULBERT & BERGHOFF
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO IL 60606In re Application of
Roninson, et al.
Application No. 10/010,167
Filed: December 10, 2001
Attorney Docket No. 93,354-SSOFFICE OF PETITIONS
DECISION DISMISSING
PETITION

This is a decision on the March 29, 2002 petition requesting that the January 22, 2002 "Notice to File Corrected Application Papers" in the above-identified application be withdrawn.

Applicant filed this above-cited application on December 10, 2001. However, on January 22, 2002, the Office mailed a "Notice to File Corrected Application Papers" stating that the application had been accorded a filing date of December 10, 2001 and advising applicants that the drawing of Figures 1K and 1L described in the specification appeared to have been omitted.¹

In response, applicants filed the present petition, a \$130.00 petition fee, the fulfillment of the sequence listing requirement under 1.821, this petition to include inadvertently omitted drawings, a substitute specification and drawings, and a request for a corrected filing receipt. Applicants explain that the application indicated the entire disclosure of the prior application is considered as being part of the disclosure of the application and that the entire disclosure of the prior application was expressly incorporated by reference. Applicants state that the missing figures were part of the prior application.

However, it appears that the Figures 1K and 1L were not present on the filing of the above-identified application. Accordingly, the "Notice to File Corrected Application Papers" mailed on January 22, 2002 was correct in stating that Figures 1K and 1L described in the specification had been omitted. Therefore, the "Notice to File Corrected Application Papers" was properly mailed and will not be withdrawn.

Accordingly, the petition is dismissed.

The \$130.00 petition fee will not be refunded because the present petition was not necessitated by any error on the part of the United States Patent and Trademark Office.

It is noted that the application transmittal letter identified this application as a divisional application of prior application No. 09/568,315, filed May 9, 2000, and specifically incorporated by reference the disclosure of the prior application. Section 201.06(c) of the Manual of Patent Examining Procedure states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior

¹ The notice also noted that the papers did not contain proper margins. In addition to the missing figures, the notice required a substitute specification, a copy of a computer readable formatted sequence listing, and a statement that the sequence listing information is the same as that on the computer readable format and that it contains no new matter.

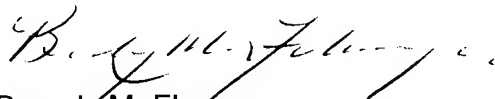
application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, the drawing of Figures 1K and 1L is not new matter if it was a part of the disclosure of the prior application.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of December 10, 2001 in accordance with this decision.

Thereafter, the application will be forwarded to Technology Center 1600 for consideration by the examiner of the petition filed this petition as an amendment requesting the entry of Figures 1K and 1L.

Any inquiries related to this decision should be directed to Attorney Scott M Ledford at (703) 306-5593.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy